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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,282	02/16/2005	Eddy Boucke	BER-101-PCT/US	7823
61215	7590	03/04/2009	EXAMINER	
DAVID I. ROCHE			SCHATZ, CHRISTOPHER T	
BAKER & MCKENZIE LLP				
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CHICAGO, IL 60601			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,282	Applicant(s) BOUCKE, EDDY	
	Examiner CHRISTOPHER SCHATZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-9 and 11-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiers (US 20030159385) in view of Cornell (US 4348448) and MacDonald (US 4008551).

Theirs discloses a method of making a floor panel comprising: providing a panel body with a core, a top side with a top surface layer 4, and a side surface extending traverse to the top surface layer. Theirs further discloses forming a bevel 11 wherein the side surface intersects the top surface layer, and placing a decorative top layer 12 upon said formed bevel. Theirs is silent as to a method of forming a recess extending under the top surface layer from the side surface into the panel body by leaving a freestanding ledge including said top surface layer wherein said recess has opposing first and second recess surfaces and is open at the side surface. Additionally, it is unclear if Theirs discloses closing a recess by fixing the first and second recess surfaces to one another, thereby forming a floor panel having a beveled top edge with the top surface layer extending continuously and in one piece from the top side of the core over the beveled top edge.

Cornell discloses a method of forming a laminated plywood panel, said method comprising providing a panel body comprising a panel core 11, a surface layer 12, and

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a side surface (figure 1). Cornell further discloses forming a recess 22 extending under the top surface layer from the side surface after the top layer is laminated to the core (column 4, lines 5-14 and lines 32-38). The recess formed by Cornell has opposing first and second recess surfaces (figure 4, surfaces that define recess 22) and the reference discloses closing said recess by folding over an edge of the recess panel such that a smooth joint end is produced (figure 6, figure 8; column 1, lines 36-55).

MacDonald disclose a method of forming a laminated panel wherein a formed recess is closed by fixing a top layer comprising a top and bottom surface to the top of a panel core with said formed recess, wherein a portion of the bottom surface of the top layer is fixed to a opposing recess surface (figure 6; column 3, line 55 – column 4, line 2). The method produces a panel with having a beveled top edge with the top surface layer extending continuously over the top side and of the core and over the beveled portion of the top of the core such that no unsightly joint lines are present at the interface between the top of the core and the beveled portion of the core

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of Theirs such that the top laminated decorative layer (4 and 12) is placed continuously over the entire core before the beveled 11 of Theirs is formed as taught by Cornell above as doing such allows the panel to be formed in a continuous and efficient manner (Cornell, column 5, lines 30-39).

Additionally, at the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of Thiers such that the top surface layer is placed continuously over the entire core as taught by MacDonald such that

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when the recess formed by the method of Thiers as modified by Cornell is closed according to teachings of MacDonald, a panel is formed without unsightly joint lines.

Modifying Thiers according to Cornell as discussed above would produce a method wherein the bevel is formed *after* the top surface layer is placed over the entire core. Modifying Thiers according MacDonald would produce a method wherein the bevel 11 is formed from the side surface extending under the top surface such that a freestanding ledge including the top surface is formed. Such a modified method would produce a recess defined by the top surface layer and the bevel 11, with a first and second recess surfaces and is open at the side surface of the core. Furthermore, one of ordinary skill in the art would have been motivated to close the recess formed by the modified method discussed above because doing such formed a bevel edge without unsightly joint lines.

As to claim 2, the recess of Thiers as modified by Cornell and MacDonald discloses a wedge shape.

As to claim 3, the first recess surface is arranged adjacent to and essentially parallel to said top surface layer in the method of Thiers as modified by Cornell and MacDonald. As to claim 4, the first and second recesses are plain in the method of Thiers as modified by Cornell and MacDonald. As to claim 5, Thiers does not disclose applying adhesive to the recess. However, Cornell teaches that before folding to close the recess, an appropriate adhesive should be deposited to surfaces (20), (21), which are located in the recess (col. 4 lines 55-64 and figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to apply adhesive to core disclosed

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by Thiers in the step of closing the recess as taught by Cornell in order to enhance the adhesion between veneer and the core. As to claim 6, the step of closing the recess necessarily includes the step of applying pressure to the ledge in order to fold the ledge over the beveled edge. As to claim 7, the ledge consists essentially of said top surface layer in the invention of Thiers as modified by Cornell and MacDonald et al. As to claim 8, the floor panel includes a joining element for connecting to a further joining element of an adjacent floor panel in a floor covering formed by said floor panels which is formed at the same time as the beveled edge ([0051] and [0052] in Thiers). When Thiers is modified by Cornell, the step of forming a recess occurs at the same time as the step of forming the joining elements. The limitations of claim 11 have been addressed in the rejection of claim 1. Claims 12-18 are rejected as claims 2-8, respectively.

3. Claims 9 and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiers, Cornell and MacDonald et al. as applied to claims 1 and 18 above, and further in view of Turner (US 4704834).

It is unclear whether the combination of references above discloses the step of removing material from the side surface adjacent to said recess to provide a flushing side surface after having closed said recess. However, Turner discloses that for a finished look, the veneer overlay of a panel is trimmed off (col. 3 lines 28-30). It would have been obvious to one of ordinary skill in the art at the time of invention to trim the veneers as taught by Turner in order to provide a finished look in the method of Thiers as modified by Cornell and MacDonald et al. Claim 19 is rejected similarly. As to claim 20, the claim combines the limitations of claims 1 and 9, and the reference meets the

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limitations of the claim for the reasons presented in the discussion of claims 1 and 9 above. As to claims 21-23, the combination of Thiers in view of Cornell and MacDonald disclose the limitations of said claims for the reasons presented above in the discussion of claims 2-4, respectively. As to claims 24 and 25, the applicant is referred to the discussion of claims 7 and 8 above.

Response to Arguments

4. Applicant's arguments filed on 12/17/2008 have been fully considered.

The applicant states that neither the method disclosed by Cornell nor MacDonald results in a recessed side surface and a free standing ledge including the top layer left after forming the recess. These arguments amount to individual attacks on both Cornell and MacDonald without considering Theirs *in combination with* Cornell and MacDonald. Applicant is reminded that one cannot show nonobviousness by attacking references individually and in a vacuum of each other as a rejection under 35 U.S.C. 103 is a consideration relating to the combined teachings of the references (and not each reference in a vacuum of the others). Whether or not Cornell *alone* discloses a freestanding ledge is not germane to the rejection as currently applied, because the method of Theirs as modified by Cornell and MacDonald would yield a freestanding ledge. The applicant is referred to the examiner's new grounds of rejection above. Furthermore, the applicant argues that MacDonald discloses a method wherein the recess is formed from the top surface and not the side surface, and the top surface layer is placed on the core after the formation of the recess. These arguments are moot in light of the examiner's new grounds above rejection presented above. It is

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unnecessary for MacDonald to disclose applying a top surface layer before formation of the recess because Cornell discloses such. Additionally, Thiers discloses forming a bevel at the side surface of the panel core. The advantages disclosed by MacDonald of using a continuous top surface layer in the method of Thiers (as opposed to the formation of separate layers 4 and 12) are not negated by MacDonald disclosure that the recess is not formed at the side surface.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791